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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,569	02/25/2002	Joe Pasqua	505102000500	8640
7590	02/08/2005			
Tyler S. Brown Morrison & Foerster LLP 2000 Pennsylvania Ave., N.W. Washington, DC 20006-1888				EXAMINER BHATNAGAR, ANAND P
				ART UNIT 2623 PAPER NUMBER

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/080,569	PASQUA, JOE	
	Examiner Anand Bhatnagar	Art Unit 2623	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 25 February 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02/25/02 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/25/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 1, 5, and 7 refer to a source document and/or a non-source document or a semantically rich document and a semantically poor document, respectively, but the word "document" is not defined. Generally a "document" is usually read as a hardcopy of an image, text, etc. The source document/semantically rich document, in the specifications (paragraph 0017), is described as the digital image of the original while the non-source document/semantically poor document is described as a hardcopy of the original. The limitations as stated do not make it clear if the applicant is referring to a digital image, a hardcopy, or both a digital version and a hardcopy. Further applicant inserts a watermark into a source document but this is unclear if it is being embedded in a hard copy and/or the digital version while the specifications state that the watermark is being inserted into the digital

image. Also, applicant detects a watermark in a non-source document/semantically poor document but does not state if it is performed on the hardcopy or the scanned copy of this document, while the specifications states in paragraph 0017 that this is performed on the hardcopy while paragraph 0019 states it is performed on a digital image that is in one of the formats of TIFF, GIF, or JPEG, which are contradictory.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a source document/semantically rich document being a digital image, does not reasonably provide enablement for inserting a watermark information into the features of the source document since the word "document" is not defined in the claim language as being a digital image and/or a hardcopy, while the specifications specifically state that the watermark is inserted into a digital form (specifications paragraph 0017). Therefore, examiner is unsure if the watermark is a digital code being inserted into a digital image or a physical watermark being inserted into a hardcopy. Also, applicant detects a watermark in a non-source document/semantically poor document but does not state if it is performed on the hardcopy or the scanned copy of this document, while the specifications states in paragraph 0017 that this is performed on the hardcopy while paragraph 0019 states it is performed on a digital image that is in one of the formats of TIFF, GIF, or JPEG, which are contradictory. The specification does not enable any person skilled in the art to which it pertains, or

with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (US pub. 2003/0002710 A1).

Regarding claims 1 and 7: Rhoads discloses a method of watermarking a document (paragraph 0016, wherein the identification code is read as a watermark) comprising:

acquire a source document (paragraphs 0050, 0064, and 0065, wherein the original image is read as the source document. The image is taken, scanned and digitized);

analyzing the source document for features (paragraphs 0054 and 0066-0068, wherein the features of the original image are determined such as noise, brightness, etc.);

inserting watermark information into the features of the source document (paragraphs 0052, 0053, and 0070-0072, wherein a N-bit code word is embedded into the original image "source document");

determining detection information (paragraphs 0075-0078, wherein the x and y parameters of equation 2 are determined and are used to make distributable copies from the original. These variables/parameters are later used to determine if the suspect copy is from the original. These parameters are read as detection information since they are used to determine the copy and/or the watermark);

storing the detection information (paragraphs 0059 and 0078);

acquiring a non-source document (paragraphs 0057, 0080, and 0081, wherein the suspect image is read as the "non-source document");

scanning the non-source document (paragraph 0059 and 0081, wherein the suspect image is scanned));

locating the features in the non-source document using the detection information (paragraphs 0057 and 0083-0086, wherein the suspect image "non-source document" is analyzed for its features and is compared to the original image "source document" using the parameters "detection information"); and

determining a watermark value of the non-source document (paragraphs 0062 and 0087, wherein the 32 bits of the identification code "watermark values" are determined).

Regarding claims 2 and 8: The method of watermarking a document wherein the detection information includes information of the location of the features (paragraphs 0075 and 0076, wherein other parameters of the detection parameters, n and m, show the positions of rows and columns, i.e. the locations).

Regarding claim 3: The method of watermarking a document wherein the source document is a semantically rich document and the non-source document is a semantically poor document (paragraphs 0050 and 0057, wherein the original image "source document" is read as a semantically rich document because inherently an original will have more information/data than a copy of an original, i.e. in this case the suspect image "non-source document").

Regarding claims 4 and 9: The method of watermarking a document according to claim 3, wherein the non-source document is a hardcopy of the source document (paragraph 0080, wherein the suspect image "non-source" is from a magazine "hardcopy").

Regarding claim 5: This claim is rejected for the combination of reasons of claims 1 and 3.

Regarding claim 6: The method of watermark detection wherein the semantically rich document is an electronic document (paragraphs 0050 and 0064-0066) and the semantically poor document is a hardcopy (paragraph 0080 and see claim 4 above).

Regarding claim 10: A system for watermark detection, comprising:

a first system connected to a document source (paragraphs 0064 and 0065, wherein a scanning system is attached to the computer. The scanning system is read as the first system and the computer as the "document source" since the computer stores the original image);

a publication component connected to the first system (paragraph 0078. wherein distributable copies can be made from the original. i.e. a publication component connected to the computer);

a second system connected to a scanning device (paragraph 0073, wherein a bandpass filter is incorporated and is read as the second system); and  
a watermark detector connected to the second system (paragraph 0087, wherein the watermark detection/comparison device is attached).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

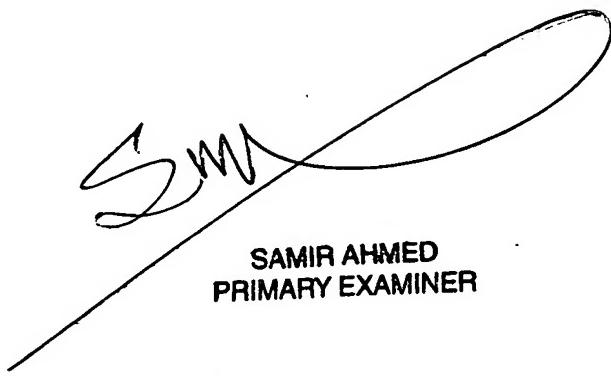
Rhoads (5,748,783) for a watermarking system.

### **Contact Information**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand Bhatnagar whose telephone number is (703) 306-5914, whose supervisor is Amelia Au whose number is 703-308-6604,

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group fax is 703-872-9306, and Tech center 2600 customer service office  
number is 703-306-0377.



A handwritten signature in black ink, appearing to read "SA", is written over a large, thin-lined oval. Below the oval, the name "SAMIR AHMED" is printed in a bold, sans-serif font, followed by "PRIMARY EXAMINER" in a smaller, all-caps font.



Handwritten initials "AB" in black ink.

Anand Bhatnagar

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February 06, 2005